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09/237,827	01/27/1999	JOHN S. HENDRICKS	026880.00013	7009

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EXAMINER	
SALCE, JASON P	

ART UNIT	PAPER NUMBER
2421	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)	
	09/237,827	HENDRICKS ET AL.	
	Examiner	Art Unit	
	Jason P. Salce	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31,63 and 107-109* is/are pending in the application.

4a) Of the above claim(s) *32-62 and 64-106* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31,63 and 107-109* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/2/2009 have been fully considered but they are not persuasive.

Applicant has amended the claims to recite, "***generates a searchable menu of the electronic books in the electronic book collection***" and "***means for selecting search criteria for the searchable menu based on at least one of the subscriber-entered selection and the subscriber-defined selection***". The Examiner notes that these limitations still read on the Duga prior art reference of record used in the previous rejection.

Duga teaches generating a searchable menu of the electronic books in the electronic books collection (**see Column 2, Lines 29-46 and Column 3, Lines 50-56 for generating and displaying a searchable menu of electronic books**). Duga further teaches a process for continually updating a dynamic menu based on previous menu selections of electronic books in the dynamic menu (**see Column 3, Line 61 through Column 5, Line 42 and Figures 3-4**), which selects search criteria for the searchable menu based on the subscriber-entered selection (**see Column 4, Line 17 through Column 5, Line 42 and Figure 4 for selecting a tag after a user makes a selection (*based on the subscriber-entered selection*) which is used to select criteria to manipulate the dynamic menu**). Note the updated rejection below.

Election/Restrictions

Applicant is reminded that withdrawn claims 32-62 and 64-106 must include cancellation of nonelected claims. The Restriction Requirement has been made FINAL. See MPEP § 821.01.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 3/24/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 7-8, 10-13, 18-19, 22-24, 26-29 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,093,718 to Hoarty et al. in view of Kubota (U.S. Patent No. 5,506,902) in further view of Redford et al. (U.S. Patent No.

5,624,265) in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195,667).

Regarding Claim 1, Hoarty discloses a system for transmitting and receiving text (Col. 6, Lines 36-39) and displaying an indication of the text (Col. 11, Lines 11-23), wherein the text is transmitting in an electronic signal (Col. 8, Lines 18-54), the system comprising a processor (See Figure 2, head-end computer 8) that produces an electronic signal containing a representation of the textual data as stated above, a transmitter connected to the processor (Col. 8, Lines 30-34) and a connector (home interface controller, See Figure 1, 16 and Col. 5, Lines 24-30) that receives the electronic signal (Col. 5, Lines 31-34 and Col. 8, Lines 7-9). Further disclosed is a TV (See Figure 3, 38). This reads on the claimed display, connected to the connector (home interface controller) that displays a particular library menu (Col. 13, Lines 17-20) relating to the textual data and based upon a subscriber-entered selection (Col. 11, Lines 11-23).

Hoarty also discloses means, connected to the connector (see remote controls 40 and 56 and remote control infrared transceiver 78), for selecting a portion of the textual data (see Column 9, Lines 7-10 and Column 10, Lines 34-39 and Column 11, Lines 11-15 and Lines 42-46), comprising means for receiving a subscriber entry indicating a title of the textual data (see Column 12, Lines 28-35 for showing the user titles of programs to select and by the use of the remote control, select a channel (see Column 15, Lines 5-6)), wherein the title correlates to a portion of the textual data (note

that the channel selected inherently correlates to a portion of the textual data (the title displayed in the program guide)).

Hoarty fails to teach offering the interactive service of electronic books that can be selected in an interactive guide.

Kubota discloses a library (see recorder 7 in Figure 14) that stores an electronic collection of electronic books (see Column 9, Lines 15-28) and a menu generator that determines whether to generate a menu of the books located in the collection based on a subscriber's entry and a default menu (see Column 9, Lines 1-9 and Column 10, Lines 1-9 for instructing the system to display an initial page which displays a list of potential books, where the list is displayed first and therefore the user must select the list from a previously displayed page).

Kubota further discloses associating subscriber-created data (user request) with individual electronic books located in the collection of electronic books (see Figures 12(a) through 12(b) and Column 9, Lines 1-9) and displaying the subscriber-created data (selected book) associated with each of the books included in the particular menu (see again Figures 12(a) through 12(b) and Column 9, Lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the electronic book system, as taught by Redford, using the electronic book system with menu generation, as taught by Kubota, for the purpose of presenting substantially no inconvenience in displaying only a selected article (see Column 10, Lines 8-9 of Kubota).

Although Kubota teaches that electronic books can be transmitted electronically, as well as Hoarty and Kubota both teaching a home subsystem (see Figure 8 of Hoarty and Figure 1 of Kubota), Hoarty and Kubota fail to teach that the electronic books can be ordered and transmitted electronically via a transmitter.

Redford discloses ordering and transmitting electronic books via transmitter (see Column 15, Lines 39-50), wherein in response to a transmitted order, the ordered electronic book is transmitted from a remote operations center to the home subsystem and stored in the library unit of the home subsystem until a selection is received to view the electronic book (see Figures 1E and 4A-4B and Column 13, Line 34 through Column 14, Line 9 and Column 18, Line 57 through Column 21, Line 57).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Hoarty and Kubota, using the ordering process, as taught by Redford, for the purpose of utilizing remote storage devices that are capable of storing a greater amount of electronic book content (see Figure 1E for multiple remote storage devices 132A-132D).

Hoarty, Kubota and Redford fail to teach means for storing the subscriber-created data with individual electronic books located in the collection of electronic books.

Tanigawa also discloses a means for associating subscriber-created data with individual electronic books located in the collection of electronic books (**see the third embodiment in Figure 11 and Column 10, Line 17 through Column 11, Line 41**) and a means for storing the subscriber-created data with individual electronic books

located in the collection of electronic books (**see marker storage unit 122 in Figure 11**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Hoarty, Kubota and Redford, using the page marking feature, as taught by Tanigawa, for the purpose of easily retrieving pages in an electronic book system (**see Column 4, Lines 5-6 of Tanigawa**).

Hoarty, Kubota and Redford and Tanigawa fail to teach means for receiving one of a subscriber-entered selection or a subscriber-defined selection and generating a particular library menu based on the received selection.

Duga discloses receiving a subscriber-entered selection and generating a particular library menu based on the received selection or a default menu (**see Figures 3 and 4A-4B and Column 3, Line 40 through Column 5, Line 42**).

Duga teaches generating a searchable menu of the electronic books in the electronic books collection (**see Column 2, Lines 29-46 and Column 3, Lines 50-56 for generating and displaying a searchable menu of electronic books**). Duga further teaches a process for continually updating a dynamic menu based on previous menu selections of electronic books in the dynamic menu (**see Column 3, Line 61 through Column 5, Line 42 and Figures 3-4**), which selects search criteria for the searchable menu based on the subscriber-entered selection (**see Column 4, Line 17 through Column 5, Line 42 and Figure 4 for selecting a tag after a user makes a**

selection (*based on the subscriber-entered selection*) which is used to select criteria to manipulate the dynamic menu).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the menu display functionality, as taught by Hoarty, Kubota and Redford and Tanigawa, using the dynamic menu functionality, as taught by Duga, for the purpose of displaying and updating a dynamic menu on a display screen of a viewing device when it is on-line with a server (**see Column 1, Lines 45-47 of Duga**).

Regarding Claim 2, Hoarty discloses a system as stated above in Claim 1, wherein the processor produces the electronic signal as a video formatted composite signal (Col. 8, Lines 30-46).

Regarding Claim 7, Kubota discloses a default menu (see Figure 12(a)).

Regarding Claim 8, Hoarty discloses a system as stated above in Claim 1, wherein the connector (home interface terminal) comprises a set top terminal (Col. 5, Lines 24-27) with a memory (See Figure 8, 80). It is inherent in such a GUI-based system with on-screen text and icons (Col. 7, Lines 1-6) that data must be stored memory. Further disclosed is that the display comprises a television (See Figure 9, 38).

Regarding Claim 10, Hoarty discloses a system as stated above in Claim 1, wherein the head-end system transmits digital data using a modulated carrier (Col. 8, Lines 35-42) on an analog television channel. This reads on the claimed processor (head end computer) comprising an encoder.

Regarding Claims 11 and 12, Hoarty discloses a system as stated above in Claim 1, wherein the head-end broadcasts data over a cable TV system (Col. 8, Lines 43-46). This reads on the claimed transmitter module comprising a broadcast television transmitter.

Regarding Claim 13, Hoarty discloses a system as stated above in Claim 12, wherein the connector (home interface controller) is connected to the cable television network (See Figure 9). This reads on the claimed connector comprising a cable connector. The connector receives interactive data on a dedicated television channel (Col. 13, Lines 1-25). This reads on the claimed extracting textual data from the video formatted composite signal (CATV signal).

Regarding Claim 18, see Claims 1 and 10 above.

Regarding Claim 19, see Claim 2 above.

Regarding Claim 22, Hoarty discloses a method as stated above in Claim 18, further comprising receiving an indication of a selected portion of the textual data identified by the menu and displaying the selected portion of the textual data (Col. 7, Lines 1-6).

Regarding Claim 23, see Claim 7 above.

Regarding Claim 24, Hoarty discloses a method as stated above in Claim 18, wherein the set top terminal receives a video signal from the CATV network (See Figure 3) as stated above. Further disclosed is that the set top terminal has a memory (See Figure 8, 80) for storage of selected textual data, as stated above. Also, the set top terminal uses a television (See Figure 3, 38) to display the menu, as stated above.

Regarding Claims 26 and 27, see Claims 10 and 11 above, respectively.

Regarding Claim 28, Hoarty discloses a method as stated above in Claim 19, wherein the head-end transmits the text data in an RF carrier using modulation (Col. 8, Lines 35-46) in a separate channel space between physical TV channels. This reads on the claimed sending textual data without any video. The textual data is received by a node, which then supplies the data via a dedicated full-bandwidth video channel to the user (Col. 13, Lines 1-10 and Lines 21-58). This reads on the claimed using the textual

data to fill an entire channel of video, and using a cable television transmitter to send the textual data.

Regarding Claim 29, see Claim 13 above.

Regarding Claim 63, see Claim 1 above.

Referring to claims 107-109, see the rejection of claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 5,210,611 to Yee et al in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195,667).

Regarding Claim 3, Hoarty, Kubota, Redford, Tanigawa and Duga disclose a system as stated above in Claim 1, but fail to teach that the processor produces the electronic signal as a signal to be transmitted over a telephone system.

Yee discloses a system for transmitting and receiving teletext (Col. 9, Lines 55-58) for use on a television (Col. 6, Lines 39-43). Yee further discloses that data may be transmitted over telephone lines and received at the user's terminal via a modem (Col. 9, Lines 63-67). Yee is evidence that ordinary workers in the art would appreciate the ability to use an electronic signal transmitted over a telephone signal in a television-based text transmission system.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty, Kubota, Redford,

Tanigawa and Duga, with the telephone transmission of data of Yee in order to allow users to receive data from other private sources as taught by Yee (Col. 9, Lines 63-67).

Claims 4-5, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 5,632,022 to Warren et al in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195,667).

Regarding Claim 4, Hoarty, Kubota, Redford, Tanigawa and Duga disclose a system as stated above in Claim 1, but fail to teach that the display displays an electronic representation of books on a bookshelf, related to the textual data.

Warren discloses a graphical user interface (Col. 6, Lines 19-22) that uses a bookshelf metaphor (See Figure 1, Col. 6, Lines 1-10 and 36-43) to browse and query (Col. 7, Lines 29-32) information. Warren is evidence that one of ordinary skill in the art would appreciate the ability to represent data as books on a bookshelf.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty, Kubota, Redford, Tanigawa and Duga with the bookshelf metaphor of Warren in order to present users with an immediately familiar method of accessing data as disclosed by Warren (Col. 6, Lines 39-67).

Regarding Claim 5, Hoarty discloses a system as stated above in Claim 1. Further, Hoarty in view of Warren discloses a system as stated above in Claim 4.

Warren further discloses formatting the menu according to category (See Figure 1 and Col. 7, Line 48-64).

Regarding Claims 20 and 21, see Claims 4 and 5 above, respectively.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 4,361,848 to Poignet et al in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195,667).

Regarding Claim 6, Hoarty, Kubota, Redford, Tanigawa and Duga disclose a system as stated above in Claim 1, wherein the set top comprises a microprocessor (See Figure 8, 80) that receives an indication of a selected portion of the textual data identified by the menu (Col. 10, Lines 10-14), and wherein the display displays the selected portion of the textual data (Col. 7, Lines 1-6), but fail to teach that the display comprises the microprocessor that receives the indication.

Poignet discloses a teletext system for broadcasting pages to a television receiver wherein the reception terminal may be integrated with the television receiver (Col. 4, Lines 51-60). This reads on the claimed display comprising a microprocessor.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty, Kubota, Redford, Tanigawa and Duga with the set top integrating with the television of Poignet in order to

reduce the cost and complexity of the user's systems as well as the required wiring/setup.

Claims 9, 14-17, 25 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota, in further view of Redford in further view of U.S. Patent No. 5,475,399 to Borsuk in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195,667).

Regarding Claim 9, Hoarty, Kubota, Redford, Tanigawa and Duga disclose a system as stated above in Claim 1, but fail to teach that the display comprises a portable, hand-held viewer.

Borsuk discloses a hand-held portable reading unit (See Figure 1) that is connected to a computer and modem (See Figure 5 and Col. 6, Lines 1-20) for reading text (Col. 4, Lines 35-41 and Col. 5, Lines 57-67).

Borsuk is evidence that ordinary workers in the art would appreciate the ability to use a portable device to read textual data.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty, Kubota, Redford, Tanigawa and Duga with the portable reader of Borsuk in order to allow a user to read content wherever or whenever they choose (Col. 1, Lines 23-29).

Regarding Claim 14, Hoarty, Kubota, Redford, Tanigawa and Duga disclose a system as stated above in Claim 1. Hoarty in view of Borsuk further discloses a system

as stated above in Claim 9. Borsuk further discloses a library unit, such as a computer (See Figure 5), connected to a connector such as a modem (Col. 6, Lines 15-17), for processing textual data. The PC acts as a mass storage database (Col. 6, Lines 1-2) that receives data from remote locations as stated above. This reads on the claimed digital logic for screening textual data and a memory for storing the data. Further, a viewer (See Figure 1) interfaces with the library unit electronically (See Figure 5 and Col. 6, Lines 4-9), the viewer displaying the textual data as text (Col. 5, Lines 57-67).

Regarding Claim 15, Hoarty, Kubota, Redford, Tanigawa and Duga in view of Borsuk disclose a system as stated above in Claim 14. Borsuk discloses that a PC (library unit) stores text files (Col. 6, Lines 15-17) for transmission to a portable reader as stated above. Further disclosed is that the PC contains a screen and a user interface, such as a keyboard (See Figure 5 and Col. 6, Line 10). It would be obvious to one having ordinary skill in the art at the time the invention was made that a computer with a display that stores text files locally would be able to display the stored text files with a viewer such as a text viewing program. This reads on the claimed library unit (computer) and viewer (viewing program) being contained within a common housing.

Regarding Claim 16, Hoarty, Kubota, Redford, Tanigawa and Duga in view of Borsuk disclose a system as stated above in Claim 14. Borsuk further discloses that the portable viewer has a memory (See Figure 2, RAM 44) for storing text data (Col. 4, Lines 35-39) received from the library unit (Col. 6, Lines 1-9). Further disclosed is a

microprocessor (40) connected to the second memory (See Figure 2) for controlling the functions of the viewer. Also disclosed is a digital display circuit (50) for creating displays (Col. 4, Lines 15-18) and a liquid crystal display (Col. 3, Line 49) connected to the digital display circuitry (See Figure 2, 8) for displaying text.

Regarding Claim 17, Hoarty, Kubota, Redford, Tanigawa and Duga in view of Borsuk disclose a system as stated above in Claim 14. Borsuk further discloses that the portable viewer comprises a storage media device insert port in which an EEPROM memory device is received (Col. 3, Lines 57-62). This reads on the claimed second memory comprising a removable electronic card memory.

Regarding Claim 25, see Claim 9 above.

Regarding Claims 30 and 31, see Claims 14 and 15 above, respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2421

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August 24, 2009